

U.S. Serial No. 09/462,845

REMARKS

In Response to the Restriction Requirement of September 27, 2001, Applicant elected the Claims in Group I with traverse. Also, in this Response mailed December 18, 2001, Applicant cancelled Claims 12-16 and added new Claims 17-21, in order to correct a numbering error in the application as originally filed. As Applicant indicated in the Response to the Restriction Requirement, there was no Claim 12 in the application as originally filed (*i.e.*, the application was originally filed with Claims 1-11, and 13-16). Thus, Applicant submits that by canceling Claims 12-16 and adding Claims 17-21, Applicant was in compliance with 37 C.F.R. 1.126, as the original numbering of the Claims was preserved and the new Claims added in the Response to the Restriction Requirement began with the next consecutive number (*i.e.*, Claim 17). Thus, Applicant respectfully submits that the Claims as filed and indicated in the Response to the Restriction Requirement were correct. Thus, Claims 1-7, 9-11 and 17-21 were pending. However, as the Examiner reiterated the Claim numbering objection, Applicant amended Claims 17-21 to Claims 16-19. Thus, Claims 1-7, 9-11 and 16-19 were pending. In a Response filed November 26, 2002, Applicant cancelled Claims 2 and 18 without prejudice. Thus, the pending Claims are 1, 3-7, 9-11, 16-17, and 19.

Applicant appreciates the Examiner's withdrawal of the previous rejections and objections. Applicant herein addresses the Examiner's remaining rejections in the following order:

- 1) Claims 1, 3-7, 9-11, 16-17, and 19 remain rejected under 35 U.S.C. §112, first paragraph, as allegedly not meeting the written description requirement; and
- 2) Claims 1, 3-7, 9-11, 16-17, and 19 remain rejected under 35 U.S.C. §112, first paragraph, as allegedly not meeting the enablement requirement.

1) The Written Description Requirement is Met

The Examiner has maintained the rejection of Claims 1, 3-7, 9-11, 16-17 and 19 under 35 U.S.C. §112, first paragraph, as allegedly not meeting the written description requirement. Applicants must respectfully disagree.

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The Examiner argues that "[t]he specification does not contain any disclosure of the structure and function of all mutant SP1 genes resulting from mutation or deletion of part or all of the SP1 gene." (Office Action, page 3). Although Applicant must respectfully disagree with the Examiner's argument and rationale, in order to further the prosecution of the present application and Applicant's business interests, yet without acquiescing to the Examiner's arguments, Applicant has amended Claims 1 and 11 to recite that the mutation or deletion is in the catalytic triad of the SP1. This amendment finds support in the Specification as filed and does not constitute new matter. Applicant reserves the right to pursue the same or broader Claims in a subsequent application. Also, as the Examiner has not provided any arguments regarding the rejection of Claim 9 and this Claim does not recite mutant SP1, Applicant respectfully submits that this pending Claim is allowable. Thus, Applicant respectfully requests that this rejection be withdrawn and the Claims passed to allowance.

3) The Claims are Enabled

The Examiner has rejected Claims 1, 3-7, 9-11, 16-17, and 19, as allegedly being non-enabled. Applicant must respectfully disagree. The Examiner argues that "... the specification does not reasonably provide enablement for gram-positive microorganism[s] having any mutation or deletion of part of [sic] all of SEQ ID NO:1 resulting in a mutant gene that inactivates SP1 proteolytic activity." (Office Action, page 3, *emphasis original*). As indicated previously, Applicant must respectfully disagree with the Examiner's argument and characterization of the pending Claims.

Nonetheless, as indicated above, in order to in order to further the prosecution of the present application and Applicant's business interests, yet without acquiescing to the Examiner's arguments, Applicant has amended Claims 1 and 11 to recite that the mutation or deletion is in the catalytic triad of the SP1. This amendment finds support in the Specification as filed and does not constitute new matter. Applicant reserves the right to pursue the same or broader Claims in a subsequent application. Furthermore, in a previous Office Action mailed January 3, 2002, the Examiner admits that the Specification is "enabling for the nucleic acid encoding serine protease of SEQ ID NO:1" (page 4). Thus, Applicant respectfully submits that all of the Claims are enabled and respectfully requests that they be passed to allowance.


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CONCLUSION

All grounds of rejection in the Final Office Action of July 16, 2003, having been addressed, reconsideration of the application is respectfully requested. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned.

Respectfully submitted,

Dated: September 24, 2003


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